



PATENT

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(P)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. Patent Application  
Ser. No. 08/809,677

) For: ARTIFICIAL LIVER APPARATUS  
) AND METHOD  
)

Applicants: Edward F. Myers et al.

) Group Art Unit: 1723  
)

Filed: February 20, 2002

) Examiner: Sun Y. Kim  
)

Allowed: October 27, 2003

Assignee: Xenogenics Corporation

**PETITION TO WITHDRAW AS ATTORNEYS**

MAIL STOP PETITIONS  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This is a Petition to Withdraw as Attorneys for Applicants and Assignee pursuant to 37 C.F.R. §§ 1.36 and 10.40 and M.P.E.P § 402.06.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Washington, DC 20231 on:

July 6, 2004

(Mailing Date)

James W. McClain

(Registered Representative)

(Signature)

July 6, 2004

(Date of Signature)



The undersigned attorneys of record, Eleanor M. Musick, et al., (collectively referred to hereinafter as "Petitioners") hereby request permission to withdraw as attorneys for Applicants Edward F. Myers et al. and Assignee Xenogenics Corporation (collectively hereinafter referred to as "the client").

The last known mailing address of the client is:

Xenogenics Corporation  
Attention: W. Gerald Newmin  
55 Access Road, Suite 700  
Warwick, RI 02886

This Petition for Withdrawal is based on 37 C.F.R. §§ 10.40(a) and 10.40(c)(1)(vi). The requirements of § 10.40(a) have been met.

The facts upon which this Petition is based are as follows. Petitioners (as part of their prior law firm, Brown Martin Haller & McClain LLP<sup>1</sup> have represented Applicants and Assignee (and Assignee's predecessors) twice with respect to the claimed invention. Petitioners originally filed the grandparent U.S. application Ser. No. 07/943,777 in 1992 for Applicants. Shortly thereafter Applicants transferred responsibility for prosecution of the application to a different law firm. At that firm PCT Application PCT/US94/10935, the parent of the present application, was filed, based on the '777 US application; the '777 application became abandoned; and in 1997 the current application [Ser. No. 08/809,677] was filed under 35 U.S.C. § 371 as a US national stage application from the PCT application.

In 1999 the current '677 application was transferred from the other firm back to Petitioners' firm for further prosecution. Because of problems with the PCT application, substantial procedural work by Petitioners was required to place the national stage application in condition for acceptance as a U.S. national application, as the PTO record will attest. Once an official filing date was accorded substantive examination on the merits took place, also requiring substantial work by Petitioners, again reflected in the PTO record. The application was thereafter allowed and the issue fee was paid. Petitioners

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<sup>1</sup> In November 2003 the attorneys of Brown Martin Haller & McClain LLP became part of the law firm of Gordon & Rees LLP and now represent the former Brown Martin Haller & McClain LLP clients as clients of Gordon & Rees LLP.



and client now await printing and issuance of the U.S. Patent.

Notwithstanding Petitioners' substantial efforts, known to and continually authorized by the client, client's payments to Petitioners for authorized work have been often overdue and in many cases entirely unpaid. In 2003 client's two principal officers agreed with Petitioners for settlement of client's arrears with full payment of the agreed-upon amount (in excess of \$35,000) to be made upon the completion of two conditions, both of which were fully met before November 2003. Since that time client has not paid any part of the agreed-upon settlement amount and an officer of client has recently stated that it will not do so.

Under 37 C.F.R. § 10.40(c)(1)(vi) Petitioners are permitted to withdraw from representation of a client who does not pay Petitioners' fees in a timely manner.

The USPTO is therefore respectfully requested to grant this Motion and allow attorney Petitioners to withdraw.

Simultaneously with this Petition, the undersigned attorneys have delivered a letter to the client with notification of their intention to withdraw from representation, and which includes a summary of the current status of the present patent including identification of forthcoming maintenance fees and dates thereof in this case which will or may require action and of which the client (and any new counsel) should be aware. Other than anticipated receipt of the issued patent, there are not to our knowledge events pending which require current action. A copy of that letter is appended hereto.

The attorneys have separately delivered to the client copies of all relevant documents from the subject patent file and have notified the client that it can hereafter communicate directly with the USPTO or communicate through new counsel of its selection. It is noted that throughout Petitioners' tenure as representatives of client, copies of all official papers, responses thereto and other relevant correspondence and documents have been provided by Petitioners to client at the time of their receipt or submission. It is therefore Petitioners' belief that client has or should have its own complete record of the prosecution of this application. Petitioners have retained a partial archival copy of the file for their own records.

The client has not consented to this Petition for Permission to Withdraw.

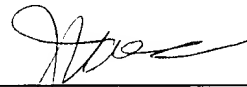
This Petition is submitted and is signed by James W. McClain, Registration No. 24,536, behalf of all of the following attorneys of record: Eleanor M. Musick<sup>2</sup>, Registration No. 35,623; Neil F. Martin, Registration No. 23,088; John L. Haller, Registration No. 27,795; and James W. McClain, Registration No. 24,536; as well as any and all other registered representatives who at relevant times may have been members of the firms of Brown, Martin, Haller & McClain LLP and/or Gordon & Rees LLP.

It is the undersigned attorneys' belief that no fee is required for the filing or consideration of this Petition. Should any such fee be required, however, the Patent and Trademark Office is authorized to charge Deposit Account No. 50-1990 for such fee. A duplicate copy of this Petition is enclosed in connection with the charge to the Deposit Account.

Respectfully submitted,

Date: July 6, 2004

By: \_\_\_\_\_



James W. McClain  
Attorney for Applicant  
Registration No. 24,536  
(On his own behalf and on  
behalf of the other named  
attorneys)

GORDON & REES LLP  
101 W. Broadway, Ste. 1600  
San Diego, California 92101

Telephone: (619) 230-7454  
Facsimile: (619) 696-7124  
Docket No. BXENO 1028470  
[formerly 7728 PA 01]

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<sup>2</sup> Ms. Musick left the Brown Martin Haller & McClain LLP firm in 2000 and has not been affiliated with Gordon & Rees LLP.

JAMES W. MCCLAIN  
DIRECT DIAL: (619) 230-7454  
EMAIL: JMCCLAIN@GORDONREES.COM

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GORDON & REES LLP

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July 6, 2004



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VIA FEDEX

W. Gerald Newmin  
Xenogenics  
55 Access Road, Suite 700  
Warwick, RI 02886

Re: **Withdrawal from Representation;  
Notice of Pending Matters**  
Our Ref. BXENO 1028469 (formerly 7728)

Dear Mr. Newmin:

Enclosed please find a copy of the Petition we have sent to the U.S. Patent and Trademark Office (USPTO) requesting that they approve our withdrawal from representation of Xenogenics, in view of your failure to pay accumulated fees arrearage, notwithstanding your agreement with us for that payment. We have also noted your statement to Mr. NePote of our finance department that Xenogenics will not honor that agreement.

We have contacted Mr. Howard, whom you indicated was Xenogenics' general attorney in San Diego, and while Mr. Howard has called us briefly twice, he has not responded substantively to our letters or phone calls to him regarding the payment.

We cannot continue to provide services to a client who does not honor its obligations to pay for those services.

**Consequently effective as of the date of this letter the firms of Gordon & Rees LLP and Brown Martin Haller & McClain LLP both withdraw from representing Xenogenics for any matters including but not limited to intellectual property matters, whether domestic or foreign. Note the following pages of this letter, where matters requiring your attention are identified.**

We anticipate that that withdrawal as to the U.S. patent application will shortly be confirmed by the USPTO. We have also notified all of the foreign associate law firms involved with Xenogenics applications that we have withdrawn from representation of Xenogenics.

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W. Gerald Newmin  
July 6, 2004  
Page 2 of 3

In the case of the USPTO, Xenogenics may continue matters with the present application and the ensuing patent directly on its own, or may retain a representative attorney or agent who is registered with the USPTO. We have provided your address to the USPTO. It is our understanding that Mr. Howard is not registered with the USPTO. As to the foreign cases, we have notified the foreign patent firms that they should correspond directly with you from now on.

We are forwarding to you under separate cover copies of the relevant documents from our files. You will recognize these as documents of which Xenogenics has in the past also received copies, either through you or Greg Szabo, and which you will have retained in your files.

**Please be aware of the following:**

1. The issue fee has been paid to the USPTO for issuance of the U.S. Patent based on your U.S. patent application. It is our understanding that the USPTO has directed its printer to print the patent for issuance, and that the order is now in the printing queue for printing in due course. We have not yet received any indication from the USPTO as to exactly when the patent will be printed and issued. However, no further action is required on your part or ours for the patent ultimately to be printed and issued.

It is unlikely that the USPTO will complete changing its mailing address in the file of your application prior to issuance of the patent. Therefore we anticipate that when the patent issues it will be mailed to us, notwithstanding our withdrawal from representation. If we do indeed receive the patent, we will send it on to you promptly and will take no further action with respect to it.

**Three "maintenance fees" must be paid to the USPTO during the life of a U.S. patent if the patent is to obtain its full term.** The maintenance fees occur at 3, 7 and 11 years following the issuance of the patent. In each case there is a six-month period starting with the 3rd, 7th and 11th anniversaries of the issue date in which the fee is to be paid. Thus if your patent issues before the end of 2004 (as is likely) the respective maintenance fee periods will start in 2007, 2011 and 2015. A further six-month "surcharge" period follows the initial payment period, during which a missed maintenance fee can be paid with the addition of a surcharge penalty. If a maintenance fee is not paid during either the initial period or the surcharge period the patent will lapse. Currently the respective maintenance fees are \$455, \$1045 and \$1610 for small entity patent owners and \$910, \$2090 and \$3220 for large entity patent owners. As USPTO fees usually increase at least once per year, you can anticipate that those fee will be greater by the time they come due in your case.

W. Gerald Newmin  
July 6, 2004  
Page 3 of 3

The USPTO does not notify patent owners by correspondence of upcoming maintenance fees. Rather, once a patent issues, its entire maintenance fee schedule is published by the USPTO on its Internet Web site, to which you can make reference.

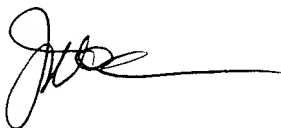
2. **We have received a communication from the Japanese associate regarding an Official Action issued by the Japanese patent examiner.** We have included a copy with the copies of the documents from the file of the Japanese application and a second copy is enclosed with this letter. **A response is due by August 24, 2004.** We have notified the Japanese associate of our withdrawal of representation and have provided him with your name and address (a copy of the letter is enclosed). There is ample time for you to correspond with the Japanese associate yourself or retain new patent counsel to do the correspondence.

3. All foreign applications and issued patents are subject to "annuities." These are analogous to the U.S. maintenance fees, but most due annually, usually on the anniversary of the international filing date of the application. You should consult with the associate attorneys in each country about their notification to you of the appropriate due dates in their countries.

We use an international payment service for payment of annuities. We are notifying them that we no longer represent Xenogenics and providing your address to them if you wish to use them in the future.

Our withdrawal from representation of Xenogenics effected in this letter is not and shall not be construed to be a waiver of our rights to payment of the amounts duly owed to us by Xenogenics.

Yours very truly,



James W. McClain  
Partner  
Gordon & Rees LLP  
Brown Martin Haller & McClain LLP

JWM:j  
Encs. (3)

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